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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/725,928	12/03/2003	Motoki Kakui	50212-556	4477
7590	04/11/2006		EXAMINER	
MCDERMOTT, WILL & EMERY 600 13 th Street, N.W. Washington, DC 20005-3096			DIACOU, ARI M	
			ART UNIT	PAPER NUMBER
			3663	
DATE MAILED: 04/11/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/725,928	KAKUI ET AL.
	Examiner Ari M. Diacou	Art Unit 3663

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 24 February 2006.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-19 is/are pending in the application.  
 4a) Of the above claim(s) 6,7 and 19 is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-5 and 8-18 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 28 June 2004 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 12 and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite in that it fails to point out what is included or excluded by the claim language. This claim is an omnibus type claim.

6. Claims 12 and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite. The negative limitations in claims 12-13 render the metes and bounds of the claim unascertainable, as applicant has not, and cannot, make a positive recitation of all the possible codopants that are not  $Al_2O_3$ .

7. It appears that claims 12 and 13 were meant to be dependent claims. Correcting their dependency will no longer make 12 and 13 omnibus claims.

#### ***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-5 and 8-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Kondo et al. (PGPub No. 2002/0041436).

- Regarding claims 1-5 and 8-11, Kondo discloses composition B1 in Table 2 of the specification.
- Regarding claims 12-13, Kondo discloses composition B<sup>7</sup> in Table 2 of the specification.

**DETAILED ACTION**

***Election/Restrictions***

1. Applicant's response to the single species election is considered to be a composition consisting of SiO<sub>2</sub>, Al<sub>2</sub>O<sub>3</sub>, BaO, and bismuth dopant. For the purposes of examination, Bi dopant will be considered equivalent to Bi<sub>2</sub>O<sub>3</sub>, since this is the oxide that is typically used in making preforms,
2. Claims 6-7 and 19 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species (the single species elected contained silicon dioxide, aluminum oxide, bismuth dopant and barium oxide), there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 2-24-2006.
3. The applicant argues that the "rather complex restriction requirement is difficult to understand and appears more theoretical than practical." The examiner assumes the applicant is referring to the single species election. The single species election is a tool that is outlined in the MPEP section 803.02 and may be employed any time a Markush type claim is used by the applicant. As for its practicality, it fixes for the remainder of prosecution, the exact combination of elements (in the Markush group) that will be examined.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

- Regarding claims 14-16, Kondo discloses his glass's use in optical amplifiers, the amplifying wavelength as well the pumping wavelength in paragraphs [0001-0006].

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

12. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

13. Claims 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kondo as applied to claims 1-5, and 8-16 above, and further in view of Wysocki et al. (USP No. 6396623). Kondo discloses the invention with all the limitations of claim 14, but fails to disclose two optical amplifier stages in series with absorption peaks 70 nm apart. Kondo teaches two optical amplifier stages in series [Fig. 19] with peak absorption wavelengths more than 70 nm apart [Fig. 13]. Wysocki is silent on the fiber compositions of each stage, however it is well-known in the art (evidenced by Kondo) that many different fiber compositions are available to one skilled in the art some using  $\text{Al}_2\text{O}_3$  as a codopant, and some using  $\text{Bi}_2\text{O}_3$ . Therefore, it would have been obvious to one skilled in the art (e.g. an optical engineer) at the time the invention was made, to make an optical amplifier disclosed by Wysocki with a fiber of Kondo, for the advantage of Kondo's fiber's hardness.

### ***Conclusion***

14. While patent drawings are not drawn to scale, relationships clearly shown in the drawings of a reference patent cannot be disregarded in determining the patentability of claims. See In re Mraz, 59 CCPA 866, 455 F.2d 1069, 173 USPQ 25 (1972).

15. The references made herein are done so for the convenience of the applicant.

They are in no way intended to be limiting. The prior art should be considered in its entirety.

16. The prior art which is cited but not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ari M. Diacou whose telephone number is (571) 272-5591. The examiner can normally be reached on Monday - Friday, 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Keith can be reached on (571) 272-6878. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Ricardo Palabrida  
Primary Examiner  
AU 3663

AMD 4/6/2006